

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

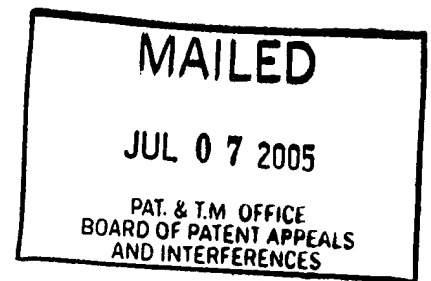
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD CHANG and AMMY CHOU

Appeal No. 2005-1396
Application 09/739,990

ON BRIEF



Before FRANKFORT, McQUADE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 44. Of the other claims in the application, we note that the record reflects that claims 1, 37 through 39 and 43 have been canceled and that claims 46 through 48 have been withdrawn from consideration, but does not clearly indicate the status of claims 2 through 36, 40 through 42 and 45.

Appellants' invention is directed to a hand-held electric sealer, and more particularly to an electric sealer like that seen in Figures 20 and 21 of the application drawings. Claim 44 reads as follows:

44. A hand-held electric sealer comprising
- a) a housing,
 - b) a press bar having a free end, said press bar being pivotally connected to said housing,
 - c) a metal press plate remote from said free end of said press bar for normally biasing said press bar in an open position, wherein said metal press plate is secured to said press bar,
 - d) a heating unit,
 - e) a source of current, and
 - f) circuitry electrically connecting said heating unit and said source of current, wherein said circuitry is normally in an open state,
- wherein when said free end of said press bar is pivoted downwardly said metal press plate switches said circuit from an open state to a closed state.

The prior art references of record relied upon by the examiner in rejecting claim 44 are:

Chou ('123)	5,142,123	Aug. 25, 1992
Netherlands ('359)	542,359	Nov. 14, 1955
Taiwanese ('687)	040,687	Apr. 01, 1988

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Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chou ('123) in view of Netherlands ('359) and Taiwanese ('687).

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding that rejection, we make reference to the supplemental examiner's answer (originally mailed Dec. 5, 2003 and re-mailed May 4, 2004) for the reasoning in support of the rejection, and to appellants' brief (filed November 25, 2002), reply brief (filed March 10, 2003) and supplemental reply brief (filed July 6, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claim 44, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination which follows.

In the rejection of claim 44 under 35 U.S.C. § 103(a), the examiner points out that Chou ('123) discloses an electric heat sealer comprising a housing (1), a press bar (2) pivotally connected to the housing, a heating unit (6) including a heating wire (67) and a support base (63) movably mounted in the housing (1), a source of current (10), and circuitry connecting the heating unit and the source of current. As noted on page 5 of the supplemental answer, the examiner recognizes that Chou ('123) does not disclose or teach a heating unit mounted in the press bar or a metal press plate like that set forth in claim 44 on appeal secured to the press bar. To account for the above-noted differences between Chou ('123) and appellants' claimed subject matter, the examiner turns to Netherlands ('359) and Taiwanese ('687), urging that Netherlands ('359) shows an electric heat sealer including a heating unit (7, 8) mounted in the press bar, and that Taiwanese ('687) shows an electric heat sealer with a metal press plate (14) positioned on the base (10) so that when the free end of the press bar (20) is pivoted downwardly the metal press plate contacts metal tongues (15) of the circuitry to switch the circuit from an open state to a closed state.

From the above-noted disclosures, the examiner has concluded that it would have been obvious to one of ordinary skill in the

art at the time the invention was made to utilize in Chou ('123) a heating unit mounted in the press bar as taught by Netherlands ('359) in order to provide heat directly to the object from the top,¹ and to provide an arrangement therein like that in Taiwanese ('687) so that when the free end of the press bar (2) is pivoted downwardly a metal press plate causes the circuit to close and activate the heating mechanism.

Moreover, the examiner recognizes that such a combination of the applied prior art references would still not result in a structure like that claimed by appellants and thus makes the further contention that

[w]ith regard to "said metal press plate is secured to said press bar", Taiwanese '687 only shows said metal press plate is secured to a base (10) instead of a press bar. It would have been obvious to one having ordinary skill in the art at the time the invention was made to secure a metal press plate to a press bar, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *Japikse*, 86 USPQ 70" (supplemental answer, page 6).

¹ It is not entirely clear why the examiner is making this particular modification in Chou ('123), since claim 44 on appeal does not include any such requirement. Claim 44 sets forth that the electric sealer therein includes a "heating unit," but does not specify exactly where the heating unit is located on the device.

Appellants argue, and we strongly agree, that the examiner has merely asserted that the combination of Chou ('123), Netherlands ('359) and Taiwanese ('687) would have been obvious to one of ordinary skill in the art at the time the invention was made, and has not set forth adequate reasoning or motivation for the wholesale changes proposed in the electric sealer of Chou ('123). Like appellants, it appears to us that it is only by looking to the disclosure of the present application, and thus relying on impermissible hindsight, that one of ordinary skill in the art would have been led to the particular changes in Chou ('123) urged by the examiner. As our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

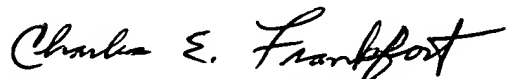
Moreover, even assuming for argument sake that the combination of Chou ('123), Netherlands ('359) and Taiwanese ('687) as urged by the examiner were to be made, we agree with appellants' assessment in the supplemental reply brief (pages 5-6) concerning the examiner's further contention that it would have been obvious to one of ordinary skill in the art to

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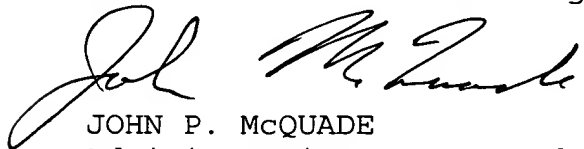
rearrange the parts of the resulting combination and change the location of the metal press plate seen in Taiwanese ('687) to be mounted to the press bar (2) of Chou ('123).

Since we have determined that the teachings and suggestions found in Chou ('123), Netherlands ('359) and Taiwanese ('687) would not have made the subject matter as a whole of independent claim 44 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a). Accordingly, the decision of the examiner to reject claim 44 is reversed.

REVERSED



CHARLES E. FRANKFORT
Administrative Patent Judge



JOHN P. MCQUADE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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